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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/804,000	03/19/2004	Masanori Itoh	250792US2	6923
22850	7590	10/30/2009		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER PARK, CHAN S	
			ART UNIT 2625	PAPER NUMBER
			NOTIFICATION DATE 10/30/2009	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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# Office Action Summary

**Application No.**

10/804,000

**Applicant(s)**

ITO ET AL.

**Examiner**

CHAN S. PARK

**Art Unit**

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's amendment was received on 6/25/09, and has been entered and made of record. Currently, **claims 1-23** are pending.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-23 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Independent claims 1, 14 and 19 recite the limitation of "a third server at the print location" and "a print server connected to a printer at the print location". Referring to corresponding Drawings (fig. 1), it describes a plurality of print servers (PS-1 ~ PS-3) connected to printers. The specification does not fully describe a third server at the print location. Can the entire network in fig. 1 be

construed as the print location? Clarification/explanation from the Specification is respectfully requested.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 8-12, 14 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith U.S. Patent No. 6,151,675 in view of Nishimura JP Pub. No. 2003-030078.

**With respect to claim 1**, Smith discloses a server apparatus (DDCS 10 in fig. 1) comprising,

a first sharing unit that shares a print environment thereof with other apparatuses on a network (fig. 1), wherein the first sharing unit includes

a connection management unit that manages, in response to a print reservation input by a user, the print reservation including a print location, the connecting of the first sharing unit to a second sharing unit of a second server apparatus on the network, the second server being selected based on route information acquired based on the print location input by the user (routing/transmitting the print document to DDCS 20 in col. 5, lines 7-21); and

a transfer unit that transfers information of the print reservation and a document related to the print reservation to the second sharing unit of the second server apparatus (transferring of document to the second server in col. 5, line 33 ~ col. 6, line 23).

Smith, however, does not explicitly disclose that the document and the acquired route information is transmitted/routed to a third server and then to a print server connected to a printer at the print location specified in the print reservation.

Nishimura, the same field of endeavor of the network communication, teaches the step of transferring data from one server to another server via a plurality of other servers wherein the route information is also transmitted from the sender to the destination (paragraphs [0025] ~ [0028])

At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the printing network of Smith to include more servers as taught by Nishimura.

The suggestion/motivation for doing so would have been to transfer the print request and print document in more complex network environment.

Therefore, it would have been obvious to combine Smith with Nishimura to obtain the invention as specified in claim 1.

**With respect to claim 8**, Smith discloses the server apparatus as claimed in claim 1, further comprising: a reservation data storage unit that stores the reservation information and the document (note that the message must be stored either temporarily/permanently in order to transmit in col. 5, lines 59-67).

**With respect to claim 9**, Smith discloses the server apparatus as claimed in claim 1, further comprising: a document acquisition unit that acquires the document (note that the document must be acquired first in order to transmit in col. 5, lines 59-67).

**With respect to claim 10**, Smith discloses the server apparatus as claimed in claim 1, further comprising: a document management service unit that provides a service for managing the document (managing the print jobs in col. 5, lines 59-67).

**With respect to claim 11**, Smith discloses the server apparatus as claimed in claim 1, further comprising: a document storage unit that stores the document (note that the message must be stored either temporarily/permanently in order to transmit in col. 5, lines 59-67).

**With respect to claim 12**, Smith discloses the server apparatus as claimed in claim 1, further comprising: a print service unit that provides service related to printing (converting of document in col. 6, lines 7-23).

**With respect to claims 14 and 19**, arguments analogous to those presented for claim 1, are applicable.

5. Claims 2, 3 and 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Smith and Nishimura as applied to claim 1 above, and further in view of Goodman et al. U.S. Patent No. 7,130,921 (hereinafter Goodman).

**With respect to claims 2 and 3**, the combination discloses the server apparatus as claimed in claim 1, but it does not explicitly disclose that the connection management unit adds or deletes connection data related to or from the second sharing unit to

service data indicating other sharing units in the network that are connected to the first sharing unit, in response to a connection/disconnection request from the second sharing unit.

Goodman, the same field of endeavor of the network server managing the plurality of clients in the network, discloses a server having a connection management unit which adds or deletes connection data related to or from the second sharing unit to service data indicating other sharing units in the network that are connected to the first sharing unit, in response to a connection/disconnection request from the second sharing unit (upon receiving a connect signal the server adds the client address to the connected client list in col. 8, lines 31-34. Also, the server, according to Goodman deletes the client address upon receiving the disconnect signal from the client in col. 9, lines 31-33). Thus, the server maintains the most recent connected client list (service data) based on the connect/disconnect signal from each client in the network.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the server of Smith to include the unit for maintaining the connected client list as taught by Goodman.

The suggestion/motivation for doing so would have been to facilitate the data transfer between one server to another by accessing the network server (col. 2, lines 1-6 of Goodman).

Therefore, it would have been obvious to combine three references to obtain the invention as specified in claims 2 and 3.

**With respect to claim 5**, the combination discloses the server apparatus as claimed in claim 2, further comprising: a service data storage unit that stores the service data (storage for storing the list in col. 8, lines 31-34 of Goodman).

**With respect to claim 6**, the combination discloses the server apparatus as claimed in claim 2, further comprising: an acquisition unit that acquires the service data from the second sharing unit (receiving the IP address of the client in col. 8, lines 31-34).

**With respect to claim 7**, the combination discloses the server apparatus as claimed in claim 1, but it does not explicitly disclose a consistency check unit that checks consistency of a connection state in which the second sharing unit is connected to the first sharing unit and a disconnection state in which the second sharing unit is disconnected from the first sharing unit.

Goodman, the same field of endeavor of the network server managing the plurality of clients in the network, discloses server having a consistency check unit for checking consistency of a connection/disconnection state in which the clients are connected to the server (col. 8, lines 41-57).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the server of Smith to include the consistency check unit as taught by Goodman.

The suggestion/motivation for doing so would have been to ensure that the servers are connected for proper network transmission.



Therefore, it would have been obvious to combine three references to obtain the invention as specified in claim 7.

6. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Smith, Nishimura and Goodman as applied to claim 2 above, and further in view of Rosenzweig et al. U.S. Patent No. 5,915,096 (hereinafter Rosenzweig).

**With respect to claim 4**, the combination teaches the apparatus as claimed in claim 2, wherein the connection data related to the second sharing unit added to the service data are managed as one of upper level data, same level data, and lower level data, which indicates a hierarchical relationship between the first sharing unit and the second sharing unit within the network.

Rosenzweig teaches the method of exchanging messages indicating its hierarchical level within the network with other devices, including servers and clients (col. 5, lines 50-64 & col. 10, lines 4-22).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the server of Smith to include the means for generating the hierarchical level of connected clients/servers in the network as taught by Rosenzweig.

The suggestion/motivation for doing so would have been to provide more efficient communication network system by informing its hierarchical level and by maintaining the hierarchical list.

Therefore, it would have been obvious to combine four references to obtain the invention as specified in claim 4.

7. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Smith and Nishimura as applied to claim 1 above, and further in view of Cantwell U.S. Patent No. 6,542,892.

**With respect to claim 13**, the combination discloses the apparatus as claimed in claim 1, but it does not explicitly disclose a print unit that prints the document.

Cantwell, the same field of endeavor of the network printing art, discloses a server having an embedded printer for printing documents (col. 2, lines 20-24).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the server of Smith to include the printer for printing the document as taught by Cantwell.

The suggestion/motivation for doing so would have been to provide a server for printing the document locally.

Therefore, it would have been obvious to combine three references to obtain the invention as specified in claim 13.

8. Claims 15, 16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Smith and Nishimura as applied to claim 14 above, and further in view of Goodman.

**With respect to claims 15 and 16**, arguments analogous to those presented for claims 2 and 3, are applicable.

**With respect to claim 18**, arguments analogous to those presented for claim 7, are applicable.

9. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Smith, Nishimura and Goodman as applied to claim 15 above, and further in view of Rosenzweig.

**With respect to claim 17**, arguments analogous to those presented for claim 4, are applicable.

10. Claims 20, 21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Smith and Nishimura as applied to claim 19 above, and further in view of Goodman.

**With respect to claims 20 and 21**, arguments analogous to those presented for claims 2 and 3, are applicable.

**With respect to claim 23**, arguments analogous to those presented for claim 7, are applicable.

11. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Smith, Nishimura and Goodman as applied to claim 15 above, and further in view of Rosenzweig.

**With respect to claim 22**, arguments analogous to those presented for claim 4, are applicable.

***Conclusion***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **CHAN S. PARK** whose telephone number is (571)272-7409. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CHAN S PARK/  
Primary Examiner, Art Unit 2625

October 13, 2009